



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,979	10/08/2003	Yong-Moon Choi	098390-32594	6473

26345 7590 05/03/2005

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE
1 RIVERFRONT PLAZA
NEWARK, NJ 07102-5497

EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,979	Applicant(s) CHOI ET AL.	
	Examiner SHAILENDRA -. KUMAR	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-10, 12-14, 16-19, 21, 22 and 25-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 6-10, 12-14, 16-19, 21, 22 and 25-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicants' communication filed on 1/27/05.

Claims 1, 6-10, 12-14, 16-19, 21, 22, and 25-31 are pending in this application.

Claims 2-5, 11, 15, 20 and 23-24 have been canceled.

Claim Rejections - 35 USC § 103

1. Claims 1, 6-10, 12-14, 16-19, 21, 22 and 25-31 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis(US 6,613,908) all for the reason of record.

Instant claims are directed to a process of carbamoylating an alcohol using alkali metal cyanate and an acid in the presence of an organic solvent.

As explained in the previous office action, the reference is generically teaching carbamoylating an alcohol using alkali cyanate, an acid in the presence of a solvent. See for example, column 2, lines 8-15, column 3, lines 62-65, column 4, lines 44-49, column 5, lines 7-12 and lines 33-34.

Applicants' arguments were fully considered and were not found convincing. Applicants argue that the reference is teaching carbamoylating a specific alcohol containing a sulfonyl radical and there is no teaching or suggestion in Ellis that the process disclosed therein would be suitable for carbamoylation of the special type of the alcohols, i.e. amino alcohols. The process is simply carbamoylating alcohol group, and sulfonyl group of the reference and amino group of the instant claimed methods has nothing to do with the process, absent evidence to the contrary. The examiner has not

Art Unit: 1621

seen any evidence that amino group is effected et al by the carbamoylation, and the same goes with sulfonyl group of the reference.

Applicants further argue that Ellis is using methanesulfonic acid as acid as well as trifluoroacetic acid and the former gives better results than the latter, whereas, in the instant claimed process, trifluoroacetic acid is the 2nd preferred acid. The examiner does not understand the probative value of the preference, as variation of different reagents are bound to give slightly different results. Applicants' arguments that Ellis is preferably run under anhydrous condition, the purpose of removing water is different in the reference than in herein, is of little if any probative value inasmuch as anhydrous condition is preferred in the reference as well as in herein.

No claim is allowed.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1621

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SHAILENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
4/22/05